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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,473

11/28/2003

Andrew F. Knight

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7590

08/28/2008

ANDREW F. KNIGHT

124 SOUTHAMPTON DRIVE

VINTON, VA 24179

EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

08/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/722,473	KNIGHT, ANDREW F.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/3/8</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejection of Claims

1. Applicant has not amended the claims &, for the reasons discussed below, Applicant's arguments are not found to be persuasive. While it is normal practice in this situation to repeat the previous rejection *in toto*, Examiner will not do so in this case since to do so would detract from the readability of the Office Action & therefore would impair the clarity of the record.
2. Therefore, the previous Office Action is hereby incorporated into the Office Action by reference and the rejections detailed therein are made final.

Response to Arguments

3. Applicant's arguments filed 19 May 2008 have been fully considered but they are not persuasive.
4. Applicant argues that the patent system protects invention while the copyright system protects expression. In doing so, Applicant misstates at least the purpose of the patent system. The patent system is intended "to promote the progress of science and useful arts..." (US Constitution, Article I, Section 8). As the previous Office Action points out, the patent system has always been the means by which society promotes the progress of **technology**. This concept of the purpose of the patent system predates the Constitution and permeates patent jurisprudence.
5. Applicant does not seek to advance "science and the useful arts" in the sense of technology. Applicant does not have a new technique for making movies. Applicant offers no scientific insight or technological breakthrough. On the contrary, Applicant is using the same methods used by other movie producers to make a movie.

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6. What Applicant seeks to do is to prevent any and all expression of an idea. This is not what the patent system is intended to do and Applicant cannot seriously argue that it is. The Courts have repeatedly ruled that *ideas* are not patentable. It is only the technological uses of those ideas that are patentable -- not merely the association of technology with those ideas. Recording a movie on a DVD is not a patentable technological use an idea because, as pointed out in the "printed matter" rejection, this does not cause the DVD to do anything unexpected or novel. DVDs play movies. Recording a movie that has a different plot on a DVD does not change the technology of the DVD.

7. This is what distinguishes Applicant's invention from software. Applicant argues that since software is patentable, his storylines should be patentable. But software is patentable because it embodies a technological advance. It causes the computer to behave in a new and unexpected manner to accomplish new tasks or to accomplish old tasks in a better way. Applicant's invention doesn't do that. Applicant's invention doesn't cause a computer to behave in a new or unexpected manner. It doesn't accomplish any new task or any old task in a better way. A computer or DVD player playing a DVD with Applicant's storyline on it would behave exactly as expected -- it would show the movie. There is no advance in technology.

8. Furthermore, Applicant seeks to claim the storyline itself without even a tenuous connection to technology. Claims 1-6 simply recite the idea for a storyline. It is well settled law that an idea *per se* is not patentable¹. By attempting to patent the idea for a story, Applicant is

¹ Examiner cannot allow Applicant's footnote 5 to go unchallenged. Applicant states, "Applicant does not and never has suggested that fictional storylines in the abstract are patentable." One need merely refer to Claim 1 to see that Applicant is indeed claiming the storyline in abstract. Applicant is claiming any and all expressions of this idea. Thus Applicant is claiming the idea itself.

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attempting to preempt any and all expression of that idea. This is clearly beyond the scope of the protection offered by the intellectual property law.

9. Applicant frequently quotes the *Chakrabarty* court in stating that “anything under the sun that is made by man” is patentable. That phrase is certainly very quotable – it makes the headlines and packs a punch. But hyperbole is not good law. And in fact the courts have made it quite clear that there are a number of exceptions to this sweeping generality. No one who is at all familiar with the patent law can seriously assert that the *Chakrabarty* court’s statement concerning the scope of patentable subject matter is accurate.

10. In the *Chakrabarty* case, the inventor sought to patent a technological invention. There was no question that the general subject matter was appropriate for coverage under the patent laws. The question was whether a living organism created through the use of that technology was patentable. Congress had already decided that the patent law protected technology. Thus only the extent of the technological subject matter that could be patented was in question.

11. In Applicant's case, the invention is **not** technological. Congress has visited the patent and copyright laws many times in the two centuries they have been in existence. During that time, Congress has never suggested that non-technological ideas should be patentable. Within the general framework set out by Congress, the courts have some latitude. But Applicant’s invention is not within the congressionally mandated framework. Therefore the courts have less freedom to interpret the law as including Applicant's invention as patentable subject matter. Certainly without guidance from either the Congress or the courts, the USPTO is powerless to make such a sweeping change to the scope of the patent law.

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12. Applicant describes as a “tirade” Examiner’s assertion that Applicant’s storyline patent would be completely contrary to the intent of the patent law. But certainly Applicant cannot claim that the invention represents an advance in technology. The point Examiner was trying to convey is that the patent law is intended to foster progress in technology. Not only does Applicant’s invention not represent a technological advance, it cannot be said to represent an art that is amenable to improvement.

13. A plot is an atom – it is what it is. One may like the plot or not, but it cannot be improved upon – at least not in the sense that technology can be improved upon. It can merely be changed.

14. If someone invents a new pump, people can learn things from this invention that they can apply to other pumps or to completely different fields. And while the pump may not be better than other pumps, the new pump adds to the total knowledge available in the field. Because of this increased technological knowledge, we can see progress in the art of moving fluids. Fostering this type of technological progress is the purpose of the patent system.

15. But there is no such thing as “progress” in storylines. Yes, there may be new stories, but this does not represent progress in the same way that technology progresses. One cannot say that the art of storytelling has progressed during human history. Certainly the technology applied to telling a story has progressed. We have gone from paintings on the cave wall to cuneiform, to papyrus, paper, film & now DVDs, but the stories we tell are not an “improvement” over the thrilling stories of yesteryear (to borrow a phrase). They are merely different.

16. Granting storyline patents may create an industry of people who patent storylines. But these storyline will not and cannot represent the type of improvement contemplated by the

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framers of the Constitution or by Congress. They may be different stories, but taken in the aggregate, they will not show progress in the storyteller's art that is in any way analogous to the progress in the art of moving fluids engendered by allowing pump makers to patent their inventions.

17. Applicant skips paragraph 9 of the previous Office Action in order to set up a strawman to attack. Applicant says that the entire patent system is designed to provide exclusive use of an invention for a number of years & that by suggesting that granting such a monopoly in this case would hinder progress, Examiner is suggesting that patents hinder progress in all cases. This is simply not the case.

18. Examiner was pointing out that the Congress has carefully weighed how best to carry out the task of promoting progress. They have determined that a copyright system that protects a particular expression of an idea and allows alternative expressions is the best manner for promoting the literary arts. Such a system provides an incentive for authors to write these varied expressions of the idea.

19. But granting a patent on a storyline would provide a different set of incentives. Instead of an incentive to write a novel, there would be an incentive to write a patent application. Thus the public is deprived of the novel that the "inventor" of the storyline might have written and of any other novel that might be based on the same (or similar) plot. Instead of enriching the public, the public would actually be poorer because these patents were issued.

20. Applicant's long discourse about the length of his patent application and *Apples v. Oranges* misses the point entirely. The point is that the Congress has determined that the current system is best suited to stimulate progress in the literary arts. (Progress being defined differently

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in the literary arts than in the technological arts.) By allowing storylines to be patented, the incentives would be changed. There would be a greater incentive to write a patent application than to write a book or screenplay. This is a significant change in the balance Congress has struck. The Office may not make such a change absent congressional or judicial authority.

21. Applicant uses microprocessors as an example of a patentable invention that has a short lifespan. In doing so, Applicant proves Examiner's point about the difference between storylines and patentable technology.

22. Unlike a storyline, a microprocessor is a piece of technology. When a patent for a new microprocessor publishes, the public is enriched. The public can use that disclosure to learn how to improve microprocessors. An inventor may learn something in the patent that allows him to improve another sort of microprocessor or create an entirely new field of microprocessors. This is how technology progresses. Because of this progress, the microprocessors of today will be obsolete within a short period of time.

23. But as Applicant points out, storylines never become obsolete. Gilgamesh is still as good a story today as it was 5,000 years ago. This is because there is no such thing as progress in the plot making art – at least not in the same sense that there is progress in the microprocessor art. Plots change, but they do not progress.

24. Applicant seems to be focusing on the question from the patent holder's perspective. Examiner suggests Applicant consider the question from society's perspective. If Applicant will do so, Applicant will no doubt conclude that there is a significant difference between what society gets for granting a patent for an engine, microprocessor, or piece of software and what it would get if it granted a patent for a storyline.

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25. Unlike the case where there is a patent for an engine, with storyline patents there is no *quid pro quo*. The patentee receives a monopoly on any and all expressions of an idea while the public receives virtually nothing in return. The public may receive an idea for a story, but receives no useful knowledge upon which they can build. They cannot look forward to qualitatively better stories or stories that improve as the years pass like they can when they grant patents on engines. They do not even have the artistic work that they might have had if the patent had not been granted. Furthermore they have lost the freedom to express the patented idea. From the public's standpoint, there is a huge difference between granting a patent for technology and granting a patent for a storyline.

26. As an inventor of a technological invention (US Patent Number 6,499,288), Applicant should be able to appreciate the difference between technological inventions and storylines. One of ordinary skill in the rocket engine art should be able to look at Applicant's rocket engine patent and learn. He may be able to apply principles learned from Applicant's rocket engine patent to other problems in the rocket engine art. Or someone in the pump art may be able to apply principles learned from the patent to pumps in a completely different field. But there are no such principles to be learned from Applicant's storyline applications.

27. Applicant argues over the course of several pages that there is no "technological arts" requirement for patentability. Examiner has, he believes, provided arguments in support of such a requirement. Examiner will be very happy to leave the question to any court of competent jurisdiction.

28. Applicant's rather exhaustive discussion of whether or not something that is intended to entertain may be patentable is moot. Examiner does not contend that entertainment technology

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is not patentable -- to do so would be to say examiner should not have a job since he works in an art unit devoted to electronic games. Examiner certainly agrees that entertainment technology is patentable. But a storyline is not technology.

29. With regard to the 1st Amendment, Applicant mistakenly assumes that the Patent Office mistakenly assumes that Constitutional restraints apply *carte blanche* to individual citizens.

What Examiner intended to convey is that 35 USC §101 cannot be interpreted as allowing the **government** to issue a patent on a storyline because such a governmental action would abridge the freedom of speech.²

30. Applicant's arguments about actions by patentees are not at issue. It doesn't matter whether the patentee is a "state actor" or not. What is at issue is whether the government can issue someone a monopoly on the expression of an idea. Examiner contends that to do so would be to abridge the freedom of speech of the public. If the government says that Applicant is the only person who can express the idea embodied in his claims without fear of a lawsuit, then the **government** has taken an action that abridges the freedom of speech. The government has put expression of an idea off limits. This is clearly prohibited by the 1st Amendment.

31. It is interesting that the Applicant discusses the *Harper & Row* case yet seems to miss the point entirely. The court states:

The Second Circuit noted, correctly, that copyright's idea/expression dichotomy "[strikes] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression." 723 F.2d, at 203. No author may copyright his ideas or the facts he narrates. 17 U. S. C. § 102(b). See, e.g., *New York Times Co. v. United States*, 403 U.S. 713, 726, n. (1971) (BRENNAN, J., concurring) (Copyright laws are not

² As for Applicant's statement that "every patent restricts expressive freedom to some extent", the decision to include a certain rocket motor in a rocket is not speech and there are certainly no 1st amendment implications to limiting this form of "expression" -- if expression it may be called.

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restrictions on freedom of speech as copyright protects only form of expression and not the ideas expressed); 1 Nimmer § 1.10[B][2]. As this Court long ago observed: "[The] news element--the information respecting current events contained in the literary production--is not the creation of the writer, but is a report of matters that ordinarily are *publici juris*; it is the history of the day." *International News Service v. Associated Press*, 248 U.S. 215, 234 (1918). But copyright assures those who write and publish factual narratives such as "A Time to Heal" that [557] they may at least enjoy the right to market the original expression contained therein as just compensation for their investment. Cf. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575 (1977).

32. This certainly has bearing on the current discussion. The Court indicates that the copyright law must be balanced with the 1st Amendment. There is no discussion of private actor or public actors here. The Court simply says that if the copyright laws did not achieve this balance, the copyright laws would be unconstitutional. The same analysis would apply to the patent laws.

33. Why does the copyright law pass 1st Amendment muster? Because, "[c]opyright laws are not restrictions on freedom of speech as copyright protects only form of expression and not the ideas expressed." Or as Mr. Justice Brennan said, "No author may copyright his ideas or the facts he narrates." But this exactly what Applicant seeks to do with the storyline patent. Applicant seeks to monopolize all forms of expression of an idea. This would not pass constitutional muster and the Office may not grant such a patent.

34. Applicant's discussion of the *DeSantis* and *3D Systems* cases misses the point as well. These cases are not about expression of an idea. These are cases about offering to sell an article that the defendant was not authorized to sell. Publishing a picture or description of the holster in the *DaSantis* case would not have infringed the patent. It was not the expression of the idea that

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caused trouble. In Applicant's case, any expression of the idea contained in the storyline would be an infringement of the patent.

35. Applicant's discussion of patents that involve speech fails to consider that these patents do not preclude all expressions of an idea. They may require speech in order to carry them out. But they do not prohibit any and all expression of an idea like Applicant's claimed invention does.

36. Applicant discusses the NetZero case. This case was about the use of floating windows – patented technology – not about the content of the ads contained in those windows. Simply put, the reason high priced lawyers didn't argue 1st Amendment concerns is that the 1st Amendment just didn't apply.

37. Concerning software patents, there are there are at least two significant differences between Applicant's storyline patents and software. First, software represents technology as storylines do not. Second, software patents do not prevent any and all expressions of an idea. For instance, one may discuss Signature Financial Group's patented software without infringing the patent. One may even describe it in minute detail. Publishing a program listing would not infringe the patent. But merely describing the plot of a movie made using a patented storyline would infringe on Applicant's claims.

38. Applicant's "arguments" under the heading of "Protected Speech Versus Patent System" are simply too bizarre for words. Arguments concerning nonexistent fictional short story compilers do not in any way advance our understanding of the law. The other arguments are equally off in left field. Applicant states, "Most, if not all, patented processes, machines, manufactures, and compositions of matter could be converted into First-Amendment type

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speech." This is utter nonsense. Painting words on an aircraft would not invalidate a patent because the patent claims the structure of the aircraft itself.

39. If a patent claims an airplane with two wings and a tail then the patentee is entitled to protection for airplanes with two wings and a tail. Painting "Spirit of Saint Louis" on the fuselage does not have anything whatsoever to do with whether or not the airplane infringes. The 1st Amendment guarantees the right to paint whatever a person wants, but it doesn't guarantee the right to build airplanes. The expression, not the substrate, is protected by the 1st Amendment. The technical aspects of the substrate, not the expression, may be protected by the patent laws.

40. Applicant **claims** any and all forms of expression of an idea. No matter what the substrate, Applicant wishes to preclude others from expressing the idea. Surely, the Applicant can see the difference between his claims and claims drawn to "an airplane with two wings and a tail" *vis-à-vis* the 1st Amendment.

Claim Rejections

41. Applicant contends that claim 1 does not contain any idea that is transformed by insignificant post-solution activity. Examiner will agree with half of this statement. There is no post-solution activity in claim 1. Claim 1 is an abstract idea – period.

42. Applicant seems to believe that "indicating desire" somehow transforms the claim from an abstract idea. A plot is an abstract idea. There is no physical substance to it. It is a concept. A story has no existence outside of the telling. Applicant has claimed a method of telling a story consisting of a number of plot elements. Applicant seeks to patent the plot or the idea.

Applicant is saying that he wants a monopoly on expression of the idea. Clearly Applicant

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desires a patent on the idea itself. If an idea cannot be expressed without violating Applicant's patent, then Applicant has a patent on the idea. Dressing the claim up with words like "indicating desire" does not change this underlying fact.

43. Applicant's non-response to the *Gottschalk* argument, fails to acknowledge the many ways in which Examiner has shown that the claimed invention is an abstract idea that is analogous to a mathematical formula.

44. Applicant's so-called preemptive arguments merely reinforce Examiner's rejection. For instance, Applicant cites *AT&T v Excel*, which states in pertinent part, software is patentable is it "applies [a] Boolean principle to produce a useful, concrete, tangible result **without pre-empting other uses of the mathematical principle.**" (Emphasis added.) The point that Examiner made in the previous Office Action and has repeatedly made in this Office Action is that Applicant's claims pre-empt all uses of the claimed idea. No one could convey the storyline outlined in Applicant's claims in any form whatsoever without infringing on Applicant's patent.

45. Applicant's question about DVDs containing independently patentable storylines assumes that storylines are patentable. They are not patentable, so the question is moot.

46. As for predictability, a toaster is a concrete item. If a manufacturer licenses a patent that says that the coils must be wound in a certain manner and made out of a certain material, the results will be predictable. The factory would turn out toasters with the described coils. But toasters aside, the concept of predictable results is more applicable to patents dealing with abstract materials. If, for instance, Signature Financial Group's software had taken the same input and given a different answer every time it was run, it would not be considered to produce a concrete result. If it had given different results for Signature Financial and for State Street, it

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would not be considered to produce concrete results. In Applicant's case, if we give Applicant's claims to different authors, it will produce a different result every time.

47. Examiner is not responsible for the state of the law concerning printed matter and will not comment on Applicant characterization of the law as "a big pile of indecipherable and contradictory hodgepodge". Examiner will, however, point out that Applicant did not address a single one of the cases cited as authority for the printed matter rejection. As far as Examiner can tell, none of these cases has been overruled.

48. Furthermore, software patents have absolutely nothing to do with the printed matter doctrine. Software patents do not claim the expression recorded on the disk. Software patents claim the function performed by the computer running the software. This is a significant difference. Applicant is claiming the expression not the function. It should be readily apparent to Applicant that court cases concerning software patents are not applicable to Applicant's claimed invention. If Applicant could find a case that said printing "See Dick run" in a book would make the book patentable over a book that said "See Jane walk", that would be pertinent to this discussion. But cases that discuss whether a program that causes a computer to arrive at the value of a portfolio is patentable have no bearing on this case.

49. Regarding the rejection under 35 U.S.C. §103, Applicant appears to be arguing that Examiner **should** consider making such a rejection. Examiner disagrees. Examiner has argues that it is impossible to form such a rejection (except the generalized rejection of the DVD claims). Applicant is, in effect, arguing that such a rejection is not only possible, but is expected.

50. Examiner believes it is pretty clear why it is impossible to determine the scope and content of the prior art. As explained several times, a storyline is not technology. One can

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ascertain the state of the pump art at any time by reading the patents and the non-patent literature. Looking at the literature, one can determine whether one of ordinary skill in the art would have found Applicant's rocket pump obvious. But in regard to storylines, these concepts are meaningless.

51. Applicant's suggestion that state of the art of storytelling can be determined by compiling a database of all storylines does not hold water. First of all, no such database exists is it likely to ever exist. But even if such a database existed, it would merely tell us when an anticipatory reference existed. Since storytelling deals with purely imaginary constructs, such a database would not provide objective evidence as to the state of the art. The "art" of plot making does not consist of storylines. It consists of mental manipulation of plot elements and the existence or nonexistence of these plot elements in other stories tells us nothing whatsoever about the state of the storyteller's art.

52. As for whether someone is of ordinary skill in the storyteller's art, that is impossible to determine. Again, a list of known plots tells us nothing about the ability of storytellers or the state of the art. It merely tells us what has been told before. But can it tell us what plot elements are obvious to combine? Obvious to whom? Could a storyteller in Hammurabi's court have conceived of Applicant's claimed story? Certainly. Was it within the level of ordinary skill at that time? Examiner could certainly say it was and since the human mind has not changed appreciably during the intervening centuries, no one could gainsay him. A list of plot elements existent at that time tells us nothing about the ability of the storytellers or their level of skill.

53. Applicant says that the level of ordinary skill is a legal fiction. If we are going to adopt legal fictions concerning the level of ordinary skill, Examiner believes that we should adopt the

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theory that favors the applicant for a patent. But Examiner will not pretend that there can be any objective basis whatsoever for determining what the level of ordinary skill actually is.

54. With regard to paragraph 39 of the previous office action, Examiner was explaining why he was not applying the *Graham v. Deere* analysis. These are not hard questions. Examiner answers them. There is no objective evidence indicating obviousness and can be none.

Applicant's further arguments concerning objective evidence betrays a lack of knowledge concerning *Graham v. Deere*. These factors deal with evidence of unexpected results, long-felt need, etc. and have nothing to do with statements in other patents about combinability of references.

55. Regarding paragraph 40, Applicant apparently believes that Examiner is suggesting storyline patents be held to a stricter standard than other applications. Examiner explicitly states that adopting such an approach would be contrary to the intent of Congress and the plain language of the statute.

56. Applicant's argument on page 40 of his response completely ignores the fact that Examiner declines to apply art to this case. Examiner is not attempting to penalize Applicant in any way. Examiner is merely explaining why he has not made an art rejection of these claims. The fact that Applicant has felt a need to present page after page of argument on the subject suggests that perhaps Applicant sees merit in Examiner's contention that it is impossible to apply 35 U.S.C. § 103 to the details of the claims in any meaningful way. Perhaps Applicant has concluded, as has Examiner, that the reason this is not possible is because storylines are not the sort subject matter patents are intended to cover.

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57. As for the rejection over a movie recorded on a DVD, Applicant again misses the point. If the storyline patents were otherwise patentable, it would be necessary to address each element of those claims in order to make a *prima facie* case. But since those claims are not otherwise patentable, their limitations need not be addressed.

Final Remarks

58. By now, it should be clear that storylines are not patentable, if for no other reasons than because they run afoul of the 1st Amendment. The quoted section from the *Harper & Row* case amounts to a definitive statement from an authoritative source (the US Supreme Court, no less) that the government cannot give intellectual property protection to ideas as opposed to a particular expression of those ideas. By seeking to gain a monopoly on any and all expressions of a storyline, Applicant is asking the government to do what the 1st Amendment expressly forbids – abridge the freedom of speech. An objective observer would have to agree that there is no possibility whatsoever that any court in the land would interpret 35 U.S.C. §101 as allowing the Patent Office to issue such a patent.

59. As Applicant is no doubt aware, the Office has a serious backlog of cases. There are thousands of people who have applications before the Office that **do** have a chance to mature into patents. In many cases, these people have waited for years to have an examiner review their application and they are still waiting. Some of these applications have real merit. Must these people continue to wait while Applicant pursues a case that has no hope of success? Do not members of the patent community have some responsibility to drop hopeless cases? Will you continue to tie up resources that could be spent examining cases that might issue? Or will you

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file what will essentially be a frivolous appeal? Examiner sincerely hopes that Applicant will file an express abandonment in this case upon reviewing this Office Action.

Conclusion

60. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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